

REMARKS

In the Action, the Examiner contends that the priority claim for the prior foreign application and the PCT Application does not meet the priority requirements of MPEP 1842[R-1]. In response, MPEP 1842[R-1] does not appear to set forth any particular priority requirements. Further, when the subject application was filed, Applicant filed a request for priority based upon the French priority application (copy enclosed). Further, since the International Application has a filing date prior to November 29, 2000, Applicant is unaware of any additional requirements for perfecting the priority claim. If there are any additional requirements which have not been met, Applicant requests that such requirements be specifically identified.

In response to the outstanding Office Action mailed June 17, 2004, Applicant has amended claims 1-15. Claims 16-21 have been canceled and replaced with corresponding claims 22-27. Additionally, Applicant has added an Abstract of the Disclosure as required by 37 CFR 1.72(b). Reconsideration and withdrawal of the claim objections of record is requested in view of the foregoing amendments and the following discussion.

Claims 1-11 and 16-21 have been objected to by having "brackets with the reference numbers." In response, Applicant has deleted the reference numbers from claims 1-11 and 16-21.

Claims 1-11 and 16-21 have been objected to, the Examiner contending that such claims should have indentations. In response, Applicant is unaware of any requirement that claims have indentations. However, Applicant has amended claim 1 to include a limitation. Additionally, added claims 22-27 include indentations, where appropriate.

Claims 1-11 and 16-21 have been objected to, as not describing "connection between the items in the claims" and "should have means plus functional language." In response, Applicant notes that Claims 1 to 11 are method claims, and as to claimed methods steps, it is inappropriate to have connection between items in the claims or to include means plus functional language. Accordingly, reconsideration and withdrawal of this objection is requested as to claims 1-11. As to claims 16-21, such claims have been canceled and replaced with corresponding claims 22-27 in which connections between items in the claims have been specified, where appropriate, and means plus functional language has been provided, where appropriate.

In addition to addressing the foregoing issues, further amendments have been made to the claims to remove improper multiple-claim dependencies, and to otherwise conform the claims to U.S. practice.

Applicant appreciates the Examiner's indication of the allowability of claims 1-21 over the prior art. In this connection, in response, Applicant has addressed the various claim objections raised by the Examiner. Accordingly, Applicant submits that the claims pending for examination, namely claims 1-15 and 22-27 are now in condition for allowance, which early Action is requested.

If there are any fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on THURSDAY, JUNE 17, 2004, Applicant respectfully petitions Commissioner for a one (1) month extension of time, extending the period for response to MONDAY, OCTOBER 18, 2004 (October 17, 2004, being a Saturday). Attached is a check in the amount of \$272.00, which includes the amount of \$110.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(1) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN

Dated: September 23, 2004

By: _____

Eric S. Hyman, Reg. No. 30,139

**2 Attachments: (1) Abstract; and
(2) Request For Priority**

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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class Mail, With Sufficient Postage, In An Envelope Addressed To: Mail Stop Amendments, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Linda Marie DELIA

September 23, 2004

9/23/04

ESH/lmd

ABSTRACT OF THE DISCLOSURE

A method for testing an integrated circuit having memory elements which are written and/or read via an access path to the memory elements from a terminal external to the circuit. A boundary scan chain is activated to impose and/or observe logic levels on the integrated circuit inputs/outputs.